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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,414	01/06/2005	Raju Adhikari	21444-00022-US	5460

7590 03/08/2010
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EXAMINER

DICKINSON, PAUL W

ART UNIT	PAPER NUMBER
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1618

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/520,414</p>	<p>Applicant(s) ADHIKARI ET AL.</p>	
	<p>Examiner PAUL DICKINSON</p>	<p>Art Unit 1618</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 11,12,14 and 19-22.
Claim(s) withdrawn from consideration: 13,15-18,23-25 and 27-38.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Eric E Silverman/
Primary Examiner, Art Unit 1618

Continuation of 11. does NOT place the application in condition for allowance because:

The rejection of claims 11-12 and 19-22 under 35 U.S.C. 102(b) as being anticipated by US 4412033 ('033) is maintained for the reasons of record. The rejection of claims 11-12, 14, and 19-22 under 35 U.S.C. 103(a) as being unpatentable over '033 in view of US 4908406 ('406) is maintained for the reasons of record.

Applicant argues that the product of '033 (1) is not biodegradable, (2) is not biocompatible, and (3) is not curable at a temperature of 30 oC.

Applicant's arguments have been fully considered but are not found persuasive. The Examiner agrees that "biodegradable" and "biocompatible" listed in the preamble of instant claim 11 are structural limitations of the polyurethane/urea polymer composition and that in order for a prior art composition to render obvious the claims, it must be biodegradable and biocompatible. The Examiner further agrees that not every embodiment of '033 is biodegradable, biocompatible, and curable at a temperature of 30 oC (although regarding the curing temperature, see below for a note on the breadth of this limitation). As stated in the record, the embodiment of '033 that renders obvious the claimed invention is the one wherein the product is a copolymer of the formula (caprolactone triol)1-(diisocyanate)1-(pentaerythritol)1 (for a more complete explanation, see office action mailed 12/1/2009, pages 4-7). This compound is an embodiment of instant claim 11 and satisfies instant claim 11 and further satisfies the monomeric components and structures required by the independent claims (for a more complete explanation, see office action mailed 12/1/2009). This compound, (caprolactone triol)1-(diisocyanate)1-(pentaerythritol)1, contains biodegradable linkages and must therefore be biodegradable. Regarding the biocompatibility of this compound, a composition cannot be separated from its properties, and as the above compound is structurally indistinguishable from Applicant's copolymer, it must be biocompatible. Further as the above compound is structurally indistinguishable from Applicant's copolymer, it must also be curable at a temperature of 30 oC. In other words, because (caprolactone triol)1-(diisocyanate)1-(pentaerythritol)1 is structurally indistinguishable from the claimed copolymer, it must inherently be curable at a temperature of 30 oC.

In summary, that other embodiments of '033 are not biodegradable, biocompatible, or curable at a temperature of 30 oC has no force against the current rejection, the current rejection being based on the embodiment of '033 that teaches (caprolactone triol)1-(diisocyanate)1-(pentaerythritol)1.

Regarding claim interpretation, the Examiner notes that "curable at a temperature of 30 oC" is not limited to thermal curing (i.e. curing by adding heat). A polymer may be cured by a variety of techniques, including adding chemical additives, ultraviolet or electron beam radiation, etc. For illustrative purposes only, a polymer that is not curable by thermal curing at 30 oC may be curable by, say, ultraviolet radiation at a temperature of 30 oC. This polymer, which is not thermally curable at 30 oC, is still a polymer that is "curable at a temperature of 30 oC."